

Application Serial No. 10/757,196
Reply to Office Action of November 3, 2006

PATENT
Docket No. CU-3535

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REMARKS/ARGUMENTS

Claims 1, 5, 10 and 12-30 are pending.

Claims 16-30 were submitted as new claims in the amendment and response that was filed August 18, 2006, however, in the office action of November 3, 2006, claims 16-30 were considered withdrawn by the Examiner, ostensibly because none of claims 16-30 fell within the previously elected "Species A."

In addition to withdrawing claims 16-20, claims 1, 5, 10 and 12-5 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. patent number 6,227,739 to Kageyama (hereafter "Kageyama" or "the Kageyama reference") in view of U.S. patent number 5,829,976 to Green (hereafter "Green" or "the Green reference").

In response to the office action, the status of claims 16-30 are indicated in this response as being withdrawn, however, the applicant expressly disagrees with the Examiner's opinion that claims 16-20 do not fall within the previously elected species. Claims 16-30 simply narrowed the independent claims 1, 14 and 15 by reciting certain characteristics of the anesthetic that is recited in each of claims 1, 14 and 15.

As for claims 1, 5, 10 and 12-15, which were rejected under §103(a), these claims were amended in the last response to recite that the claimed applicator included an anesthetic composition. The amendment of claims 1, 5, 10 and 12-15 to add an anesthetic composition was not rejected, nor was it objected-to by the Examiner because of any sort of election.

In paragraph 6 of page 3 of the office action mailed November 3, 2006, the Examiner admitted that Kageyama does not expressly teach an anesthetic composition but the Examiner nevertheless rejected the claims as being obvious under 35 U.S.C. §103(a) because of the teachings of the Green reference, which shows an anesthetic composition being applied using a dental brush.

In response to the Examiner's rejection of claims 1, 5, 10 and 12-15 under 35 U.S.C. §103(a), the Applicant has amended each of the independent

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claims to avoid the combination of Kageyama and Green.

Paraphrased, each of the independent claims is amended to recite that the viscosity of the anesthetic within the claimed applicator is such that the anesthetic will not leak from the applicator unless a pressure is applied to the anesthetic. Support for the amendments to claims 1, 14 and 15 can be found in the specification on page 4, lines 18-23 and on page 5, lines 24-29. No new matter has been added.

The applicant submits that the amendment to the independent claims renders each of claims 1, 5, 10 and 12-15 allowable over Kageyama and Green. Reconsideration of the claims is therefore respectfully requested.

Sincerely,

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